

Remarks

3. Applicant respectfully traverses the rejection of claims 6 – 9, 12 – 13 and 29 under 35 U.S.C. §103(a) over US Patent 5,858,883 to Lam et al. (Lam '883) in view of US Patent 5,194,059 to Yesnik, US Patent 6,182,804 to Lam (Lam '804), US Publication 2004/0033341 to Lam (Lam '341). US Publication 2005/0191477 to Dong, and/or US Publication 2004/0081813 to Dong, and/or US Publication 2004/0081813 to Dong, and further in view of US Patent 6630416 to Lam, US Publication 2004/0043193 to Chen et al. US Patent 6,875,711 to Chen et al., US Publication 2004/0081813 to Dong, and/or US Publication 2005/0064778 to Lam et al.

Claims 6 – 9, 12 – 13, and 29 patentably distinguish over the combinations of references in the recitation of the secondary layer comprising about 5% to about 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere do the references even remotely disclose or suggest this. Nowhere do the references disclose any type of partially carbonized carbon fibers, let alone the partially carbonized carbon fibers Applicant claims.

Lam '883 is silent with respect to the use of carbon fibers in the secondary layer.

Lam '883 is silent with respect to the degree to which the fibers are partially carbonized.

Lam '883 is silent with respect to the claim limitation that the partially carbonized carbon fibers are 65 to 90% carbonized.

Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record.

Nowhere do any of the references disclose partially carbonized carbon powders, particles, or fibers. Nowhere do any of the references disclose partially carbonized carbon fibers. Nowhere do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

Applicant respectfully submits that none of the references contain a teaching of partially carbonized carbon in any form.

No factual basis exists to support the Examiner's finding of obviousness. The mere existence of the key elements of what is claimed is not even found in the references. The Examiner cannot add to the references what is not there. The absence of the key elements of the claimed material in and of itself is sufficient to conclude that no case of obviousness had been established.

The Examiner states that the following patents and publications teach carbon fibers in the secondary layer:

US Patent 6194059 to Yesnick (col. 7, lines 6 – 17);

US Patent 6182804 to Lam (col. 5, lines 59+);

US Publication 2004/0033341 to Lam (paragraphs 0052 and 0053);

US Publication 2005/0191477 to Dong (paragraphs 0065 and 0096);

US Publication 2004/0081813 to Dong (paragraphs 0065 and 0096).

Nowhere do any of these references disclose partially carbonized carbon fibers. Nowhere do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

The Examiner also states that the following patents and publications teach partially carbonized powders, particles, or fibers:

US Patent 6630416 to Lam (col. 9, lines 20 – 26);

US Publication 2004/0043193 to Chen et al. (paragraph 0064);

US Patent 6875711 to Chen et al. (col. 8, lines 18 – 25);

US Publication 2004/0081813 to Dong (paragraph 0014);

US Publication 2005/0064778 to Lam et al. (paragraph 0093).

Applicant respectfully submits that more of these references contain a teaching of partially carbonized carbon in any form.

Further, none of these references disclose carbon fibers.

Nowhere do any of the references disclose partially carbonized carbon powders, particles, or fibers. Nowhere do any of the references disclose partially carbonized carbon fibers. Nor do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

Clearly the references are deficient and the Examiner is adding what is not there.

The Examiner has failed to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed. See In re Kahn, 441 F.3d 977, 985-86, 78 U.S.P.Q. 1329, 1335 (Fed.Cir. 2006). Applicants have overcome the rejection by showing insufficient evidence of prima facie obviousness); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788, (Fed.Cir. 1984).

The Examiner does not provide any evidentiary basis to support her findings. See In re Ahlert, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 420-21 (CCPA 1970).

Applicants respectfully submit that the Examiner has not even identified various claim elements in the prior art, let alone provide the requisite evidence to support her reasons for combining those elements to achieve the invention as a whole. In re Kahn, 441 F.3d at 986, 78 U.S.P.Q. at 1335 (Fed.Cir. 2006) (citations omitted).

Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection under 35 USC §103.

4. Applicant respectfully traverses the rejection of claims 6 – 9, 12 -13 and 29 under 35 U.S.C. §103(a) over US Patent 5856244 to Lam et al. (Lam '244), in view of US Patent 6194059 to Yesnick, US Patent 5856244 to Lam et al. (Lam '804), US Publication 2004/0033341 to Lam (Lam '341), US Publication 2005/0191477 to Dong, and/or US Publication 2004/0081813 to Dong, and further in view of US Patent 6630416 to Lam, US Publication 2004/0043193 to Chen et al., US Patent 6875711 to Chen et al., US Publication 2004/0081813 to Dong and/or US Publication 2004/0064778 to Lam et al.

Claims 6 – 9, 12 – 13, and 29 patentably distinguish over the combinations of references in the recitation of the secondary layer comprising about 5% to about 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere do the references even remotely disclose or suggest this. Nowhere do the references disclose any type of partially carbonized carbon fibers, let alone the partially carbonized carbon fibers Applicants claims.

Lam '244 is silent with respect to the carbon fibers. The reference also is silent with respect to the use of carbon fibers in the secondary layer. Lam '244

also is silent with respect to the claim limitation that the partially carbonized carbon fibers are 65 to 90% carbonized.

Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record.

Nowhere do any of the references disclose partially carbonized carbon powders, particles, or fibers. Nowhere do any of the references disclose partially carbonized carbon fibers. Nowhere do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

Applicant respectfully submits that more of the references contain a teaching of partially carbonized carbon in any form.

No factual basis exists to support the Examiner's finding of obviousness. The mere existence of the key elements of what is claimed is not even found in the references. The Examiner cannot add to the references what is there. The absence of the key elements of the claimed material in and of itself is sufficient to conclude that no case of obviousness had been established.

The Examiner states that the following patents and publications teach carbon fibers in the secondary layer:

US Patent 6194059 to Yesnick (col. 7, lines 6 – 17);

US Patent 6182804 to Lam (col. 5, lines 59+);

US Publication 2004/0033341 to Lam (paragraphs 0052 and 0053);

US Publication 2005/0191477 to Dong (paragraphs 0064 and 0096);

US Publication 2004/0081813 to Dong (paragraphs 0064 and 0096).

Nowhere do any of these references disclose partially carbonized carbon fibers. Nowhere do nay of these references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

The Examiner also states that the following patents and publications teach partially carbonized carbon powders, particles, or fibers:

US Patent 6630416 to Lam (col. 9, lines 20 – 26);

US Publication 2004/0043193 to Chen et al. (paragraph 0064);

US Patent 6875711 to Chen et al. (col. 8, lines 18 – 25);

US Publication 2004/0081813 to Dong (paragraph 0014);

Us Publication 2005/0064778 to lam et al. (paragraph 0093).

Applicant respectfully submits that none of these references contain a teaching of partially carbonized carbon in any form.

Further, none of these references disclose carbon fibers.

Nowhere do any of the references disclose partially carbonized carbon powders, particles, or fibers. Nowhere do any of the references disclose partially carbonized carbon fibers. Nor do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

Clearly, the references are deficient and the Examiner is adding what is not there.

The Examiner has failed to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed. See In re Kahn, 441 F.3d 977, 985-86, 78 U.S.P.Q. 1329, 1335 (Fed.Cir. 2006). Applicants have overcome the rejection by showing insufficient evidence of prima facie obviousness); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788, (Fed.Cir. 1984).

The Examiner does not provide an evidentiary basis to support her findings. See In re Ahlert, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 420-21 (CCPA 1970).

Applicants respectfully submit that the Examiner has not even identified various claim elements in the prior art, let alone provide the requisite evidence to support her reasons for combining those elements to achieve the invention as a whole. In re Kahn, 441 F.3d at 986, 78 U.S.P.Q. at 1335 (Fed.Cir. 2006)(citations omitted).

Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection under 35 U.S.C. §103.

5. In response to the provisional rejection of claims 6 – 9, 12 – 13 and 29 on the ground of nonstatutory obviousness-type double patenting over claim 9 of copending Application No. 10/666090, Applicant submits herewith a Terminal

Disclaimer obviating that rejection. Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection.

6. In response to the provisional rejection of claims 6 – 9, 12 – 13 and 29 on the ground of nonstatutory obviousness-type double patenting over claim 7 of copending Application No. 10/678599, Applicant submits herewith a Terminal Disclaimer obviating that rejection. Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection.

7. Applicant respectfully traverses the rejection of claims 6 – 9, 12 – 13 and 29 on the ground of nonstatutory obviousness-type double patenting over claims 1 – 26 of U.S. Patent No. 5998307 in view of US Patent 6194059 to Yesnik, US Patent 6182804 to Lam (Lam '804), US Publication 2004/0033341 to Lam (Lam '341), US Publication 2005/0191477 to Dong, and/or US Publication 2004/0033341 to Lam (Lam '341), US Publication 2005/0191477 to Dong, and/or US Publication 2004/0081813 to Dong, and further in view of US Patent 6630416 to Lam, US Publication 2004/0043193 to Chen et al., US Patent 6875711 to Chen et al., US Publication 2004/0081813 to Dong, and/or US Publication 2005/0064778 to Lam et al.

As the Examiner points out, US 5998307 patent includes a secondary layer of carbon particles.

Applicant respectfully submits that the Examiner's rejection is based on

impermissible hindsight reconstruction and is unsupported by the evidence of record.

No basis in fact or theory exists for using carbon fibers in place of carbon particles. Fibers provide strength to friction materials. Particles are used in combination with the fibrous materials. Particles provide high coefficients of friction to the friction material. The particles also provide the friction material with a smooth friction surface and provides a good "shift feel" and friction characteristics to the friction material such that any "shudder" is minimized. Particles and fibers are not interchangeable as the Examiner suggests. They have different functions in the friction material.

The Examiner states that the following patents and publications teach carbon fibers in the secondary layer:

US Patent 6194059 to Yesnick (col. 7, lines 6 – 17);

US Patent 6182804 to Lam (col. 5, lines 59+);

US Publication 2004/0033341 to Lam (paragraphs 0052 and 0053);

US Publication 2005/0191477 to Dong (paragraphs 0065 and 0096);

US Publication 2004/0081813 to Dong (paragraphs 0065 and 0096).

Nowhere do any of these references disclose partially carbonized carbon fibers. Nowhere do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

The Examiner argues that it would be obvious to employ carbon fibers.

Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record. No basis in facts or theory exists for substituting carbon fibers for carbon particles.

The Examiner also states that the following patents and publications teach partially carbonized powders, particles, or fibers:

US Patent 6630416 to Lam (col. 9, lines 20 – 26);

US Publication 2004/0043193 to Chen et al. (paragraph 0064);

US Patent 6875711 to Chen et al. (col. 8, lines 18 – 25);

US Publication 2004/0081813 to Dong (paragraph 0014);

US Publication 2005/0064778 to Lam et al. (paragraph 0093).

Applicant respectfully submits that none of these references contain a teaching or partially carbonized carbon in any form.

Further, none of these references disclose carbon fibers.

Nowhere do any of the references disclose partially carbonized carbon powders, particles, or fibers. Nowhere do any of the references disclose partially carbonized carbon fibers. Nor do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

Clearly the references are deficient and the Examiner is adding what is not

there.

The Examiner has failed to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed. See In re Kahn, 441 F.3d 977, 985-86, 78 U.S.P.Q. 1329, 1335 (Fed.Cir. 2006). Applicants have overcome the rejection by showing insufficient evidence of prima facie obviousness; In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788, (Fed.Cir. 1984).

The Examiner does not provide any evidentiary basis to support her findings. See In re Ahlert, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 420-21 (CCPA 1970).

Applicants respectfully submit that the Examiner has not even identified various claim elements in the prior art, let alone provide the requisite evidence to support her reasons for combining those elements to achieve the invention as a whole. In re Kahn, 441 F.3d at 986, 78 U.S.P.Q. at 1335 (Fed.Cir. 2006) (citations omitted).

Accordingly, Applicant respectfully asks that the Examiner withdraw this non-statutory double patenting rejection.

8. In response to the rejection of claims 6 – 9, 12 – 13 and 29 under the judicially created of obviousness-type double patenting over claims 1 – 18 and 20 – 23 of U.S. Patent No. 6,182,804, Applicants submit herewith a Terminal

Disclaimer obviating that rejection. Accordingly, Applicants respectfully ask that the Examiner withdraw this rejection.

9. Applicant respectfully traverses the rejection of claims 6 – 9, 12 -13 and 29 on the ground of nonstatutory obviousness-type double patenting over claims 1 – 23 of U.S. Patent No. 6,001,750 in view of US Patent 6194059 to Yesnick, US Patent 6182804 to Lam (Lam '804), US Publication 2004/0033341 to Lam (Lam '341), US Publication 2005/0191477 to Dong, and/or US Publication 2004/0081813 to Dong, and further in view of US Patent 6630416 to Lam, US Publication 2004/0043193 to Chen et al., US Patent 6875711 to Chen et al., US Publication 2004/0081813 to Dong, and/or US Publication 2005/0064778 to Lam et al.

As the Examiner points out, the issued claims of 6,001,750 includes a secondary layer of carbon particles.

Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record.

No basis in fact or theory exists for using carbon fibers in place of carbon particles. Fibers provide strength to friction materials. Particles are used in combination with the fibrous materials. Particles provide high coefficients of friction to the friction material. The particles also provide the friction material with a

smooth friction surface and provides a good “shift fee” and friction characteristics to the friction material such that any “shudder” is minimized.

Particles and fibers are not interchangeable as the Examiner suggests. They have different functions in the friction material.

The Examiner states that the following patents and publications teach carbon fibers in the secondary layer:

US Patent 6194059 to Yesnick (col. 7, lines 6 – 17);

US Patent 6182804 to Lam (col. 5, lines 59+);

US Publication 2004/0033341 to Lam (paragraphs 0052 and 0053);

US Publication 2005/0191477 to Dong (paragraphs 0065 and 0096);

US Publication 2004/0081813 to Dong (paragraphs 0065 and 0096).

Nowhere do any of these references disclose partially carbonized carbon fibers. Nowhere do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

The Examiner argues that it would be obvious to employ carbon fibers.

Applicant respectfully submits that the Examiner’s rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record. No basis in fact or theory exists for substituting carbon fibers for carbon particles.

The Examiner also states that the following patents and publications teach

partially carbonized powders, particles, or fibers:

US Patent 6630416 to Lam (col. 9, lines 20 – 26);

US Publication 2004/0043193 to Chen et al. (paragraph 0064);

US Patent 6875711 to Chen et al. (col. 8, lines 18 – 25);

US Publication 2004/0081813 to Dong (paragraph 0014);

US Publication 2005/0064778 to Lam et al. (paragraph 0093).

Applicant respectfully submits that none of these references contain a teaching or partially carbonized carbon in any form.

Further, none of these references disclose carbon fibers.

Nowhere do any of the references disclose partially carbonized carbon powders, particles, or fibers. Nowhere do any of the references disclose partially carbonized carbon fibers. Nor do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

Clearly the references are deficient and the Examiner is adding what is not there.

The Examiner has failed to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed. See In re Kahn, 441 F.3d 977, 985-86, 78 U.S.P.Q. 1329, 1335 (Fed.Cir. 2006). Applicants have overcome the rejection by showing insufficient evidence of prima facie obviousness; In re Piasecki, 745 F.2d 1468, 1472, 223

U.S.P.Q. 785, 788, (Fed.Cir. 1984).

The Examiner does not provide any evidentiary basis to support her findings. See In re Ahlert, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 420-21 (CCPA 1970).

Applicant respectfully submits that the Examiner has not even identified various claim elements in the prior art, let alone provide the requisite evidence to support her reasons for combining those elements to achieve the invention as a whole. In re Kahn, 441 F.3d at 986, 78 U.S.P.Q. at 1335 (Fed.Cir. 2006) (citations omitted).

Accordingly, Applicant respectfully asks that the Examiner withdraw this non-statutory double patenting rejection.

10. In response to the provisional rejection of claims 6 – 9, 12 – 13 and 29 on the ground of nonstatutory obviousness-type double patenting over claims 1 – 19 copending Application No. 10/678598, Applicant submits herewith a Terminal Disclaimer obviating that rejection. Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection.

11. Applicant respectfully traverses the rejection of claims 6 – 9, 12 – 13 and 29 on the ground of nonstatutory obviousness-type double patenting over claims 6 of copending application No. 10/916,328 in view of US patent 6194059 to Yesnik, US patent 6182804 to Lam (Lam '804), US Publication 2004/0033341 to

Lam (Lam '341), US Publication 2005/0191477 to Dong, and/or US Publication 2004/0033341 to Lam (Lam '341), US Publication 2005/0191477 to Dong, and/or US Publication 2004/0081813 to Dong, and further in view of US Patent 6630416 to Lam, US Publication 2004/0043193 to Chen et al., US Patent 6875711 to Chen et al., US Publication 2004/0081813 to Dong, and/or US Publication 2005/0064778 to Lam et al.

As the Examiner points out, the conflicting claim only includes a secondary layer of carbon particles.

Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record.

No basis in fact or theory exists for using carbon fibers in place of carbon particles. Fibers provide strength to friction materials. Particles are used in combination with the fibrous materials. The particles also provide the friction material with a smooth friction surface and provides a good "shift feel" and friction characteristics to the friction material such that any "shudder" is minimized. Particles and fibers are not interchangeable as the Examiner suggests. They have different functions in the friction material.

The Examiner states that the following patents and publications teach carbon fibers in the secondary layer:

US Patent 6194059 to Yesnick (col. 7, lines 6 – 17);

US Patent 6182804 to Lam (col. 5, lines 59+);

US Publication 2004/0033341 to Lam (paragraphs 0052 and 0053);

US Publication 2005/0191477 to Dong (paragraphs 0065 and 0096);

US Publication 2004/0081813 to Dong (paragraphs 0065 and 0096).

Nowhere do any of these references disclose partially carbonized carbon fibers. Nowhere do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

The Examiner argues that it would be obvious to employ carbon fibers.

Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record. No basis in fact or theory exists for substituting carbon fibers for carbon particles.

The Examiner also states that the following patents and publications teach partially carbonized powders, particles, or fibers:

US Patent 6630416 to Lam (col. 9, lines 20 – 26);

US Publication 2004/0043193 to Chen et al. (paragraph 0064);

US Patent 6875711 to Chen et al. (col. 8, lines 18 – 25);

US Publication 2004/0081813 to Dong (paragraph 0014);

US Publication 2005/0064778 to Lam et al. (paragraph 0093).

Applicant respectfully submits that none of these references contain a teaching or partially carbonized carbon in any form.

Further, none of these references disclose carbon fibers.

Nowhere do any of the references disclose partially carbonized carbon powders, particles, or fibers. Nowhere do any of the references disclose partially carbonized carbon fibers. Nor do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

Clearly the references are deficient and the Examiner is adding what is not there.

The Examiner has failed to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed.

Accordingly, Applicant respectfully asks that the Examiner withdraw this non-statutory double patenting rejection.

12. Applicant respectfully traverses the rejection of claims 6 – 9, 12 – 13 and 29 on the ground of nonstatutory obviousness-type double patenting over claims 1 – 22 of U.S. Patent No. 6,630,416 in view of US Patent 6194059 to Yesnick, US Patent 6182804 to lam (Lam '804), US Publication 2004/0033341 to Lam (Lam '341), US Publication 2005/0191477 to Dong, and/or US Publication 2004/0081813 to Dong.

Claim 5 encompasses a secondary layer of partially carbonized carbon powder or particles.

Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record.

No basis in fact or theory exists for using carbon fibers in place of carbon particles. Fibers provide strength to friction materials. Particles are used in combination with the fibrous materials. Particles provide high coefficients of friction to the friction material. The particles also provide the friction material with a smooth friction surface and provides a good "shift fee" and friction characteristics to the friction material such that any "shudder" is minimized.

Particles and fibers are not interchangeable as the Examiner suggests. They have different functions in the friction material.

The Examiner states that the following patents and publications teach carbon fibers in the secondary layer:

US Patent 6194059 to Yesnick (col. 7, lines 6 – 17);

US Patent 6182804 to Lam (col. 5, lines 59+);

US Publication 2004/0033341 to Lam (paragraphs 0052 and 0053);

US Publication 2005/0191477 to Dong (paragraphs 0065 and 0096);

US Publication 2004/0081813 to Dong (paragraphs 0065 and 0096).

Nowhere do any of these references disclose partially carbonized carbon fibers. Nowhere do any of the references disclose partially carbonized carbon fibers that are 65 to 90% carbonized.

The Examiner argues that it would be obvious to employ carbon fibers.

Applicant respectfully submits that the Examiner's rejection is based on impermissible hindsight reconstruction and is unsupported by the evidence of record. No basis in fact or theory exists for substituting carbon fibers for carbon particles.

Clearly the references are deficient and the Examiner is adding what is not there.

The Examiner has failed to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed.

Accordingly, Applicant respectfully asks that the Examiner withdraw this non-statutory double patenting rejection.

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01168/BW00076

Applicant respectfully submits that claims 6 – 9, 12 – 13 and 29 are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,

EMCH, SCHAFFER, SCHAUB
& PORCELLO CO., L.P.A.

A handwritten signature in black ink, appearing to read "Patrick P. Pacella", written in a cursive style.

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